

PATENT
Customer No. 22,852
Attorney Docket No. 08719.0171



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Marco NASSI et al.

Application No.: 09/885,940

Filed: June 22, 2001

For: SUPERCONDUCTING CABLE

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) Group Art Unit: 2827
)
) Examiner: K. Cuneo
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)

Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action dated September 11, 2002, the period for response being extended for two months by the concurrent filing of a Petition for Extension of Time and payment of the requisite fee, please reexamine and reconsider the application in view of the appended remarks.

I. Election of Claims Under 35 U.S.C. §121

In the Office Action dated September 11, 2002, the Examiner required election under 35 U.S.C. § 121 between Claims 20-35 (Group I) and 36-38 (Group II). In response to the restriction requirement, Applicants provisionally elect with traverse to prosecute Group I, Claims 20-35, drawn to a product classified in Class 174, subclass 125.1.

II. Election of Species Under 35 U.S.C. §121

In the Office Action, the Examiner has required an election of a single disclosed species from Groups a1 through Groups f2 inclusive of 12 patentably distinct species. The species relate to the structure and composition of the tubular support members. Subparagraph b of Claim 20 defines the tubular support member as a tubular element for supporting a layer of tapes.

In the Office Action, the Examiner stated that there are no current generic claims, and that a single disclosed species must be elected for examination, although this requirement may be traversed. Contrary to the position taken by the Examiner, Applicants respectfully assert that Claim 20 as written is generic to all of the species as set forth. Claim 20 generally sets forth tubular elements for supporting a layer of superconducting tapes, which tubular elements have a metallic portion, therefore, generically leaving open the possibility of the various metals and the various configurations which may be used. The alleged species are broken down by the composition of the metallic portion, as well as their structure. Should the Examiner find Claim 20 to be allowable, Applicants would expect all of the dependent claims directed to the species to be examined and allowed with the generic claim.

Applicants thank Examiner Cuneo for the courtesy of the telephone interview on October 17, 2002. During this interview, Applicants asked if "tubular support," as stated in the Office Action, references the tubular element 14 or the composite tubular element 6. In response, the Examiner stated that "tubular support" references the composite tubular element 6.

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In order to be responsive to the Office Action, Applicants provisionally elect with traverse to prosecute species c1 directed to tubular supports being copper and spirally wound. Applicants respectfully request, however, that the elected species be reevaluated, since it is Applicants' position that, at a minimum, species c1 and species c2 must be examined together. Both species c1 and species c2 require the tubular supports being copper and spirally wound, while species c2 further includes a second tape. In the event that species c1 is found allowable, species c2 must also be allowed. Thus, contrary to the position taken by the Examiner, Applicants respectfully assert that species c1 and c2 are examinable together and respectfully request that they be so examined.

Applicants further assert that the delineated species are too far reaching and at least should be reconsidered. Specifically, the species as delineated by the Examiner fall into two categories: one being structure (e.g., smooth, corrugated, or tile), and the other category being composition (e.g., copper, or aluminum). Applicants respectfully request that the Examiner reconsider the election of species requirement, and examine species a1, c1, e1, a2, c2, and e2, which are all directed to copper tubular supports, regardless of configuration. Alternatively, should the Examiner believe that examination based on configuration is the more appropriate methodology, then Applicants elect species a1, b1, a2, and b2, which are directed, for example, to smooth or corrugated tubular supports. In view of the foregoing comments, Applicants respectfully request the reconsideration of this election of species and reevaluation by the Examiner.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: December 9, 2002

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